

THIS DISPOSITION IS NOT
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NOV. 17, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ziff-Davis Publishing Company

Serial No. 75/186,845

Mark D. Engelmann of Fross Zelnick Lehrman & Zissu, P.C.
for Ziff-Davis publishing Co.

Gary R. Thayer, Trademark Examining Attorney, Law Office
103 (Michael A. Szoke, Managing Attorney).

Before Cissel, Hohein and Bottorff, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On October 24, 1996, applicant filed an application to register the mark "PC SHOPPER" on the Principal Register for goods which were subsequently specified by amendment as "printed publications, namely, magazines and newspapers, and sections and columns thereof, and supplements thereto, newsletters, journals, brochures, pamphlets and directories featuring news and information about computers, computing,

systems, technology and information networks," in Class 16; and "electronic publications recorded on cd-roms and disks, namely, magazines and newspapers and sections and columns thereof, and supplements thereto, newsletters, journals, brochures, pamphlets and directories featuring news and information about computers, computing, systems, technology and information networks," in Class 9. The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce on or in connection with the goods set forth in the application.

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of the goods set forth in the application, in that it describes "the intended readers or subject matter of applicant's publications, namely those shopping for personal computers, i.e., 'PC shopper[s].'"

When the refusal to register on this basis was made final after the resolution of several other informal problems, applicant appealed to the Board. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based on careful consideration of the written record and arguments before us.

The sole issue in this appeal is whether the term sought to be registered, "PC SHOPPER," is merely descriptive as applied to the goods identified in the application, as amended. Included in those goods are publications featuring news and information about computers.

In support of the refusal to register, the Examining Attorney made of record the copies of excerpts from stories retrieved from the Nexis® database of published articles. Examples include the following:

"... PC shoppers can expect big bargains in the second half of the year."

"... the database service takes much of the effort and guesswork out of choosing a personal computer by letting PC shoppers compare more than 4,000 systems from 200 vendors."

"thrifty PC shoppers know not to overlook the smaller companies."

"... Comparison Shopping Service, PC-Agent is utilizing Oracle Universal Data Server and Oracle Web Application Server to allow PC shoppers to compare..."

"what's more, market researcher International Data Corp. says a March survey of 30,000 potential home-PC shoppers found only one percent to two percent expressing interest in buying home PCs from Sony and Toshiba."

"in view of the growing interest in the Pentium MMX technology among PC shoppers locally..."

"... today are being made to improve the low-cost passive-matrix or dual-scan liquid crystal displays

(LCD's) that notebook PC shoppers consider the poor relations of active-matrix color screens."

In support of its opposition to the refusal to register, applicant submitted a copy of a dictionary listing for the word "shopper" which, in addition to defining a shopper as "one who visits stores in search of merchandise or bargains," also shows that the term is used to refer to "a commercial agent who compares the merchandise and prices of competing merchants," "a commercial employee who fills mail or telephone orders," and "a newspaper containing advertisements and some local news, usually distributed for free."

The test for determining whether a trademark is merely descriptive within the meaning of Section 2(e)(1) of the Lanham Act is well settled. A mark need not name the goods or services with which it is used in order to be considered merely descriptive of them. Rather, a mark is merely descriptive if, as used in connection with the goods or services, it immediately describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, or feature thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978);

In re Ethan Foods, Inc., 24 USPQ2d 1757 (TTAB 1992); and In re American Screen Process Equipment Co., 175 USPQ 561 (TTAB 1972). Further, the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is considered in connection with the goods or services, it immediately conveys information about their nature. In re Abcor Development Corp., supra. We are obligated to determine the question of registrability based on the identification of goods or the recitation of services as set forth in the application for registration, subject only to such limitations as to scope, channels of trade, etc. which are specified therein, or which are normal for the goods of the same nature. In re Allen Electric and Equipment Co., 458 F.2d 1404, 173 USPQ 689 (CCPA 1972); In re Vehicle Information Network, Inc., 32 USPQ2d 1542 (TTAB 1994); and In re Cryomedical Services Inc., 32 USPQ2d 1377 (TTAB 1994).

When this test is applied to the facts of the case at hand, we find that the mark applicant seeks to register is merely descriptive, within the meaning of Section 2(e)(1)

of the Act, of the goods set forth in the application. We agree with the Examining Attorney that the proposed mark conveys the fact that PC shoppers are the intended purchasers of applicant's products, that is to say, that the magazine will be directed to people who are shopping for personal computers.

As the Examining Attorney has pointed out, applicant has conceded that at least one portion of the audience for its publications may reasonably consist of "people who intend to buy personal computer." (Applicant's brief, p. 3, and applicant's response to the first Office Action, p. 4). Additionally, applicant has also admitted that at least one other part of the potential audience for its publications may reasonably consist of professional "shoppers" (individuals whose occupation is shopping as an agent for others) in the field of personal computers and products related to personal computers. (Request for reconsideration, p. 4).

In view of these concessions, and in light of the examples provided by the Examining Attorney of how the term "PC shopper" is used to refer to people who are shopping for PCs, it is reasonable to conclude that "PC SHOPPER," when used in connection with applicant's electronic and printed publications, would be understood as communicating

this significant information about applicant's publications. Because it names the relevant class of purchasers of the goods, the term is merely descriptive within the meaning of Section 2(e)(1) of the Lanham Act. See: Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996 (TTAB 1996) ["SYSTEMS USER" merely describes the people to whom the magazine is directed, i.e., readers or subscribers]; In re Sentry Chemical Co., 230 USPQ 556 (TTAB 1986) ["HOSPICE" immediately informs purchasers that the goods are designed for use in hospices]; and In re Camel Manufacturing Company, Inc., 222 USPQ 1031 (TTAB 1984) and cases cited therein ["MOUNTAIN CAMPER" merely describes the customer to whom applicant's retail and mail order services in the field of outdoor equipment and apparel are directed].

Applicant argues that the Examining Attorney has not properly taken into account the goods with which applicant intends to use the mark. In this regard, applicant contends that "the record is devoid of any meaningful evidence demonstrating that PC SHOPPER is merely descriptive of applicant's particular goods," but instead contains articles referring to the term in a variety of contexts without any indication that it has meaning in connection with electronic and printed publications.

Further, although applicant allows that its publications may be read by people who intend to buy personal computers, applicant argues that the mark is not merely descriptive because the identification-of-goods clause in its application does not specify that applicant's publications will be intentionally aimed at those who shop for such goods. Applicant concedes that a PC shopper is a person who is shopping for a personal computer, but applicant points to the additional meanings of the term in question and argues that these alternative meanings remove its mark from the descriptive category because the mark does not convey an immediate idea of the nature of the goods. Lastly, applicant argues that its mark is at most highly suggestive, but that even if the case were closer, any doubt must be resolved in applicant's favor, and in favor of publishing the mark for opposition.

None of these arguments is well taken. Contrary to applicant's contention, in reaching his conclusion that the mark is merely descriptive of the goods set forth in the application, the Examining Attorney has clearly considered the goods with which applicant intends to use the mark. So have we.

While the evidence does not show the term sought to be registered used in connection with publications per se, the

materials made of record by the Examining Attorney demonstrate that prospective purchasers of personal computers are referred to as "PC shoppers." As noted above, applicant admits that such people would be at least part of the market for its publications. Whether these PC shoppers are shopping for themselves, or on behalf of other people or commercial enterprises, is immaterial. Similarly, that the application does not specifically identify PC shoppers as the target audience for applicant's goods is not critical to our determination. The fact is that the proposed mark names people who are intended purchasers of the goods. The mark is therefore merely descriptive of these goods within the meaning of the Act because it immediately and forthwith communicates this significant information.

In a similar sense, we are not persuaded to reach a different result by applicant's final argument, which is that its mark is highly suggestive, but that even if we do not agree that this is so, doubt must be resolved in favor of applicant. As we have explained above, applicant's mark is merely descriptive of the products identified in the application because it identifies people to whom the goods will be marketed. We have no doubt that the mark is unregistrable under Section 2(e)(1) of the Act, so

Ser No. 75/186,845

applicant's argument regarding the resolution of doubt is inapplicable.

For the reasons set forth above, the refusal to register is affirmed.

R. F. Cissel

G. D. Hohein

C. M. Bottorff
Administrative Trademark Judges
Trademark Trial and Appeal Board

Ser No. 75/186,845